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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,238	01/31/2004	Ronald L. Darata	03-016-RD	8170
7590	09/11/2006		EXAMINER	
Lambert & Associates Suite 200 92 State Street Boston, MA 02109			MAI, HUY KIM	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/769,238	DARATA ET AL.
	Examiner	Art Unit
	Huy K. Mai	2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 June 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-94 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-71,78-94 is/are rejected.

7) Claim(s) 72-77 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Huy Mai
Primary Examiner

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 33-65 and 94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to support the limitations "at least one projection" as claimed in claim 33 and "said projection" as claimed in claim 49. Nowhere in the specification discloses such the "at least one projection".

The remaining claims are dependent upon the above rejected base claim and thus inherit the deficiency thereof.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 33-67 and 92-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The feature “at least one projection” (claim 33, line 5) renders claim unclear because lacking of the function and the location relative to other elements of the eyeglass device. The limitations “said auxiliary clip-on possess a rearwardly concave arcuate shape” in claim 38 are redundant. The phrase “said torsion bar” (claim 42, line 1) has no antecedent basic. The phrases “said outer sides” (claim 46, line 2), “said outer side” (claim 47, line 2 and claim 48, line 2), “said upper side” (claim 49, line 2) and “said auxiliary clip-on assembly frame” (claim 94, lines 3-4) also have no antecedent basis.

Regarding claims 66 and 67, the phrases “said … second end piece” (claim 66, lines 10-11) and “said auxiliary clip-on assembly” (claim 67, line 1) have no antecedent basis.

The phrase “the primary spectacle frame” (claim 92, line 7) has no antecedent basis.

The remaining claims are dependent upon the above rejected base claim and thus inherit the deficiency thereof.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao (6,505,932).

The limitations in claims 1, 2 and 5 are shown in Xiao's Fig.1, columns 3-4. Xiao discloses a primary spectacle frame assembly comprising: an eyerim 151, a first end piece 13 and a second end piece 14 attached to and extending from a first outer side and a second outer side of said eyerim; a first rimblock 17 and a second rimblock 18, a bridge 111 attached to and connecting the inner sides of said eyerim; a first temple 112; and a second temple 113.

In response to the previous action the applicant, in page 20, argues that "the first end piece 13 and second end piece 14 in the Xiao reference are of a completely different structure than those claimed in claims 1, 2 and 5". The applicant however does not point out what is "a complete different structure" in comparison with the Xiao reference to make claims patentably distinct from the Xiao reference.

In response to the dependent claim 5, the applicant, in the same page 20, further argues that "applicant claims a limitation that a primary spectacle frame wherein the two primary spectacle frame lenses are constructed of transparent material. Xiao's Figure 1 fails to disclose that the primary spectacle frame lenses are constructed of transparent material to place the matter

in the public domain". The applicant neither demonstrates the primary lens in the Xiao's primary spectacles cannot be made of a transparent material nor shows that the applicant's matter in the public domain is different from that of the Xiao reference.

8. Claims 8-13, 20, 23, 26, 27, 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (5,867,244).

The limitations in claims 8-13, 20, 23, 26, 27, 30 and 32 are shown in Martin's Figs. 1-2, columns 2-3. Martin discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses, a rear vertical surface; and a first and second end piece retainers 40,42.

In response to the previous action the applicant, in page 21, argues that "The clip-on assembly in the Martin reference ... encompasses a different structure than that claimed in claims 8-13,20,23,26,27,30, and 32". The applicant however does not point out what is "encompasses a different structure" in comparison with the Martin reference to make claims patentably distinct from the Martin reference.

9. Claims 8, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadler (5,416,537).

The limitations in claims 8, 15 and 16 are shown in Sadler's Figs. 1-3, columns 2-3. Sadler discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses 15 (see column 2, lines 55-57), a rear vertical surface; and a first and second end piece retainers 17.

Regarding claim 15, Sadler, in Fig.3, discloses that said plurality of auxiliary clip-on lenses consists of a single auxiliary clip-on lens.

10. Claims 33-40, 43-65 and 94 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (2001/0021001).

The limitations in claims 33-40, 43-65 and 94 are shown in Lee's Figs.1,2,6-8, pages 2-3. Lee discloses an eyeglass device comprising: a primary spectacle frame assembly 100 for supporting primary lenses 101 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple 104 thereto, said primary spectacle frame assembly including at least one eyerim 102, at least one projection 210, a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and an outer portion.

Regarding claim 34, Lee shows in Figs. 1, 3 and 4B that the auxiliary clip-on assembly possessing a rearwardly concave arcuate shape.

In response to the previous action the applicant, in the same page 23, that "the Examiner fails to provide a reasonable basis for stating that the Lee reference discloses the applicants' invention sufficiently to place the matter in the public domain" The applicant does not show that the applicant's matter in the public domain is different from that of the Lee reference. The applicant also argues that "The Applicant contends that the examiner fails to establish a *prima facie* case of anticipation, due to the fact that the Lee reference fails to teach or enable each of the claimed elements, either expressly or inherently, as interpreted by one of ordinary skill in the art as required under 35 U.S.C 102". The applicant does not point out which element is not disclosed by Lee reference. In fact, the examiner points out and matches the elements in Lee reference with the claimed element.

11. Claims 33, 34, 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang (6,113,234).

The limitations in claims 33,34,41,42 are shown in Huang's Figs.1,2, column 2. Huang discloses an eyeglass device comprising: a primary spectacle frame assembly 10 for supporting primary lenses 23 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple 11 thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions.

Regarding claims 41,42, the frame in the auxiliary frame inherently includes a torsion bar.

In response to the previous action the applicant argues in page 28 that "the Huang invention will not work in the case of round wire type temples which are about one millimeter in diameter". The applicant's arguments do not correspond to what the applicant claimed in claims 33, 34, 41 and 42. Such arguments would not overcome the rejection of claims 33, 34, 41 and 42 over Huang reference.

12. Claim 71 is rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson (4,217,037) or Grendelmeier (5,943,114).

The limitations in claim 71 are shown in Lemelson's Figs.1-6, columns 2-4 or Grendelmeier's Figs. 1,6,7. Lemelson discloses an auxiliary clip-on assembly comprising: a single member lens 41 possessing a front vertical surface and a rear vertical surface; a plurality of end piece retainers 44; and a plurality of fasteners wherein said plurality of end piece retainers 44 are mounted on said rear surface of said single member lens and said fasteners are mounted

on said front surface of said single member lens and wherein said fasteners couple said end piece retainers to said lens by penetrating said lens.

In response to the previous action, the applicant argues that “ ...the primary spectacle frame of the present invention. As the end piece retainers contact the primary spectacle frame from the top and bottom and the eyerims or end pieces, rather than merely resting on the top of the primary spectacle frame as in Lemelson”. The applicant’s arguments do not correspond to what the applicant claimed in claim 71.

13. Claims 79-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Ifergan (6,811,254).

The limitations in claims 79-91 are shown in Ifergan’s Figs.1-22, columns 2-6. Ifergan discloses an auxiliary clip-on assembly comprising: an auxiliary frame for housing a pair of lenses; a first and a second end piece retainer, said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed members attached to said vertically disposed member.

In response to the previous action, the applicant argues that “The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly”. The applicant’s arguments do not correspond to what the applicant claimed in claims 79-91. Such arguments would not overcome the rejection of claims 79-91 over Ifregan reference.

14. Claims 92 and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Xiao.

The limitations in claims 92,93 are shown in Xiao’s Figs.1-3, columns 3-4. Xiao discloses an eyeglass device comprising: a primary frame 10 for supporting primary lenses 121,122

Art Unit: 2873

therein; the primary frame including two side portions 13,14, a front portion and a rear portion; and the primary frame including a first and a second rimblock 17,18 respectively having a horizontal surface and being secured to one of said side portions of said primary spectacle frame; and an auxiliary frame 20 for supporting auxiliary lenses 201,202 therein and for disposing in front of the primary spectacle frame 10, the auxiliary frame 20 including an auxiliary rear portion, wherein the auxiliary spectacle frame further includes two end piece retainers 22,23 each secured to said auxiliary rear portions and having a horizontal surface for coupling a corresponding horizontal surface of one of said rimblocks so as to secure the auxiliary frame to the primary frame.

In response to the previous action, the applicant argues that “The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly”. The applicant’s arguments do not correspond to what the applicant claimed in claims 92 and 93. Such arguments would not overcome the rejection of claims 92 and 93 over Xiao reference.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao.

Regarding claims 3 and 4 since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 6 and 7, the optical properties of the lenses in a pair of spectacles depend on the needs of the user such as prescription lenses or sunglass lenses which are well known and commonly use in this art. Therefore, the limitations in claims 6,7 are unpatentable over Xiao reference.

In response to the previous action the applicant argues that “The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly”. The applicant’s arguments do not correspond to what the applicant claimed in claims. Such arguments would not overcome the rejection of claims 3, 4, 6 and 7 over Xiao reference under 35 USC 103.

17. Claims 14, 21, 22, 24, 25, 28, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin.

Regarding claims 14, 24 and 25, since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 21 and 22, absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or

adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

Regarding claims 28,29,31., although Martin device does not teach the shape and size of the auxiliary clip-on assembly being different from those of the primary spectacle frame as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Martin reference by forming an auxiliary clip-on assembly being different from the primary spectacle frame in shape and size. Such a modification would have no functional differences from the Martin reference.

In response to the previous action the applicant argues that “With respect to Martin specifically, Martin relies on clips to grasp the eyerims or bridge. The Martin device relies on a total of three clips in order to function and can only be functional when the primary frame has a small enough bridge ...”. The applicant’s arguments do not correspond to what the applicant claimed in claims. Such arguments would not overcome the rejection of claims 14, 21, 22, 24, 25, 28, 29 and 31 over Martin reference under 35 USC 103.

18. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadler.

Absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

In response to the previous action the applicant argues that “The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes

end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly". The applicant's arguments do not correspond to what the applicant claimed in claims. Such arguments would not overcome the rejection of claims 17-19 over Sadler reference under 35 USC 103.

19. Claims 66-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

It should be noted that although claims 66-70 "method claims", the method steps consist of the broad steps of "attaching", "applying" and "attaching" and therefore these steps would be inherently satisfied by the apparatus of the reference.

In response to the previous action the applicant argues in page 35 that "the Huang invention will not work in the case of round wire type temples which are about one millimeter in diameter". The applicant's arguments do not correspond to what the applicant claimed in claims 66-70. Such arguments would not overcome the rejection of claims 66-70 over Huang reference.

20. Claims 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson.

The optical properties of the lenses in a pair of spectacles depend on the needs of the user such as polarized lenses which are well known and commonly use in this art. Therefore, the limitations in claim 78 are unpatentable over Lemelson reference.

In response to the previous action, the applicant argues that "...the primary spectacle frame of the present invention. As the end piece retainers contact the primary spectacle frame from the top and bottom and the eyerims or end pieces, rather than merely resting on the top of the primary spectacle frame as in Lemelson". The applicant's arguments do not correspond to what the applicant claimed in claim 78.

Allowable Subject Matter

21. Claim 72 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
22. Claims 73-77 are objected to as being dependent upon the above objected claim.

Response to Arguments

23. Applicant's arguments with respect to claim 8 regarding the feature "a rear vertical surface" have been considered. It is agreed with the applicant that "Applicant, acting as its own lexicographer, has identified the element "a rear surface" in order to distinguish from the front and rear surfaces of the auxiliary clip-on assembly and in order to identify the location for affixation of the end piece retainers as mention in claim 16". The rejection to claim 8 under 35 USC 112, second paragraph, has been withdrawn.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.


Huy Mai
Primary Examiner
Art Unit 2873